

REMARKS

This is a full and timely response to the outstanding final Office Action mailed February 7, 2006. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 103(a)

A. Rejection of Claims 1, 2, 4-7, 9, 10, 12-15, 17, 18, 20-22, 24, and 25

Claims 1, 2, 4-7, 9, 10, 12-15, 17, 18, 20-22, 24, and 25 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Felcman, et al. ("Felcman," U.S. Pat. No. 6,205,020) in view of Anderson, et al. ("Anderson," U.S. Pat. No. 6,550,877). Applicant respectfully traverses this rejection.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference

teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.

In the present case, the prior art does not teach or suggest all of the claim limitations, and there is no suggestion or motivation in the prior art to modify the references to include those limitations.

Beginning with independent claim 1, Applicant notes that the Examiner admits that Felcman does not teach or suggest a connector panel integrated with a circuit board, the connector panel "comprising connection elements that are configured to directly connect the connector panel to a computer chassis".

In view of that shortcoming of the Felcman reference, the Examiner relies upon the Anderson reference that, it is argued, teaches such connection elements in the form of an extension 112 that extends from three sides of and I/O panel 100, that extension having tabs 108 that are configured to directly connect with slots provided on a computer chassis 102. In view of those alleged teachings, the Examiner concludes that it would have been obvious "to use a securing element design of Anderson for the securing element of Felman [sic] et al., as modified, for the purpose of enabling assembly."

As a first matter, Applicant asserts that there is no motivation provided by the prior art for such a modification of the Felcman rear portion 104, which is cited by the Examiner as comprising a "connector panel." Neither reference suggests the desirability of such a modification and the Examiner cites no other source as providing such a suggestion. Given

the lack of a suggestion contained in the prior art for the proposed modification, it is clear that the only suggestion comes from Applicant's own disclosure. As is well established in the law, such hindsight to the Applicant's own disclosure is *per se* improper. See *Crown Operations International, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002) (a determination of obviousness cannot be based on a hindsight combination of components selectively culled from the prior art to fit the parameters of the invention). In the present case, the Examiner clearly has "selectively culled" features of the prior art for the purpose of rejecting Applicant's claims.

As a second matter, Applicant notes that neither reference provides a suggestion as to *how* the Felcman apparatus can be modified to include Anderson's tabs. Indeed, it appears that a simple addition of such tabs would not be possible for the Felcman apparatus given that the Felcman rear portion 104 and the chassis 18 lack the complementary parallel surfaces on which Anderson's tabs 108 and mating latches 110 are provided. Therefore, in addition to failing to provide a suggestion to combine the teachings of the references, the prior art further fails to provide a suggestion as to how such a combination could even be achieved. This fact further underscores the unobviousness of Applicant's claimed invention. Specifically, a person having ordinary skill in the art in viewing both references would not think to add Anderson's tabs 108 and latches 110 to the Felcman rear portion 104 given that it appears that such a modification would not be feasible absent substantial redesigning of the Felcman system.

For at least the foregoing reasons, Applicant asserts that claims 1, 2, 4-7, and 9 are not obvious in view of Felcman and Anderson. Given that independent claims 10 and 14 contain limitations similar to the above-described "connection element" limitation of claim

1, Applicant further asserts that those claims, and their dependents, are also not obvious in view of Felcman and Anderson.

Regarding dependent claims 2, 7, 12, 15, and 18, Applicant notes that, contrary to that alleged in the Office Action, Felcman does not show *any* of the connectors of the rear portion 104 being “mounted to the circuit board” in Figures 2 and 3. In truth, Felcman is silent as to any relationship between the Felcman connectors 116 and the circuit board.

Turning to independent claim 21, Applicant notes that, contrary to that alleged by the Examiner, the method of claim 21 is not “inherent in the product structure” of either of the Felcman and Anderson references. In fact, the opposite is true. In particular, Felcman explicitly teaches that the board module 16 is “slidingly received in the computer 10”. Felcman, column 7, lines 33-34. Therefore, Felcman teaches the *direct opposite* of what is recited in claim 21. Given that fact, Felcman cannot possibly teach installing a motherboard module “without sliding the motherboard module into place”, and any teaching to the contrary would be *teaching away* from Felcman’s disclosure. As is well established in the law, “[t]here is no suggestion to combine . . . if a reference teaches away from its combination with another source . . . A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant . . .” *Tec Air, Inc. v. Denso Manufacturing Michigan Inc.*, 192 F.3d 1353, 52 USPQ2d 1294 (Fed. Cir. 1999).

In view of the above, it is clear that the Felcman/Anderson combination does not render claim 21, or its dependents, obvious.

In summary, it is Applicant's position that a *prima facie* case for obviousness has not been made against Applicant's claims. Therefore, it is respectfully submitted that each of those claims is patentable and that the rejection of these claims should be withdrawn.

B. Rejection of Claims 3, 11, and 16

Claims 3, 11, and 16 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Felcman, as modified, as applied to claim 1, 10, and 14, in view of Sacherman, et al. ("Sacherman," U.S. Pat. No. 5,973,926). Applicant respectfully traverses this rejection.

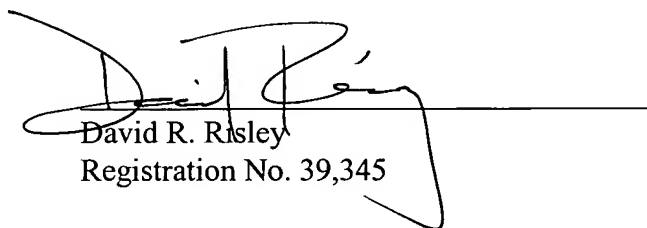
As is identified above, Felcman does not teach several aspects of Applicant's claims. In that Sacherman does not remedy the deficiencies of the Felcman reference, Applicant submits that claims 3, 11, and 16, which depend from claim 1, 10, and 14 are allowable over the Felcman/Sacherman combination for at least the same reasons that claims 1, 10, and 14 are allowable over Felcman.

As a further matter, Applicant notes that Felcman explicitly teaches that the board module 16 is configured such that it can be removed from the computer "without the need of removing fasteners, such as screws." Felcman, column 8, lines 5-13. Given that fact, Felcman cannot possibly teach a module that comprises "openings that are adapted to receive fasteners that are used to secure the circuit board to a computer chassis" as is recited in claim 3 (similar recitations contained in claims 11 and 16). Furthermore, any teaching to the contrary would be *teaching away* from Felcman's disclosure. Again, Applicant notes that it is well established in the law that there is no suggestion to combine if a reference teaches away from its combination with another source.

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Alexandria, Virginia 22313-1450, on

3-29-06

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Signature